

### **REMARKS**

The Office Action of May 5, 2006 has been carefully reviewed and this response addresses the concerns stated in the Office Action. All objections and rejections are respectfully traversed.

#### **I. STATUS OF THE CLAIMS**

Claims 1, 3, 4, 7-14, 17, 18, 21, 22, and 24-47 are pending in the application.

Claims 2, 5, 6, 15, 16, 19, 20, and 23 have previously been canceled.

Claim 18 has been objected to as being dependent on rejected base claims, but would be allowable if rewritten to include all the limitations of its respective base claim and any intervening claims.

Claims 41 and 44-45 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Mankoff, U.S. Patent No. 6,385,591, filed on May 11, 1999, issued on May 7, 2002 (Mankoff). Applicants respectfully point out that Mankoff issued almost a year after the filing date of Applicants' application (August 15, 2001). Applicants reserve the right to swear behind Mankoff under 37 C.F.R. § 1.131.

Claims 1, 3, 4, 9-14, 17, 21-40, 42-43, and 46-47 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Treyz et al., U.S. Patent No. 6,587,835, issued July 1, 2003, filed February 9, 2000 (Treyz). Applicants respectfully point out that Treyz was issued almost two years after the Applicants' filing date. Applicants reserve the right to swear behind Treyz under 37 C.F.R. § 1.131. Applicants respectfully point out that claim 23 has been rejected herein, but claim 23 had been previously cancelled. Thus, the list of claims rejected under 35 U.S.C. § 103 should read 1, 3, 4, 9-14, 17, 21, 22, 24-40, 42-43, and 46-47.

Claims 30, 43, 46-47 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Lake et al., U.S. Patent No. 6,975,835, issued December 13, 2005, filed September 7, 1999 (Lake). Applicants respectfully point out that Lake was published over four

years after the Applicants' filing date. Applicants reserve the right to swear behind Treyz and Lake under 37 C.F.R. § 1.131.

Applicants respectfully point out that the Office Action states no rejection for claims 7 and 8, and therefore allowance is earnestly solicited.

## II. CLAIM REJECTIONS UNDER 35 U.S.C. § 102

On pages 2-3, in paragraphs 2-3, the Office Action has rejected claims 41 and 44-45 under 35 U.S.C. § 102(e) as being anticipated by Mankoff.

It is submitted that claims 41 and 44 are not anticipated by Mankoff because Mankoff does not disclose that the server is performing any formatting whatsoever. Instead, Mankoff states that the virtual coupons are served with web pages in a conventional manner. Conventionally, web pages are formatted by web page designers and are provided to a server already formatted. In conventional systems, the server simply delivers the web page directly to the client when a request for the page is received. In Mankoff, a provider stores virtual coupons in a database that is accessible to the server. The server then accesses the database to serve the virtual coupons along with the web page. Since Mankoff describes this process as conventional, and since Mankoff nowhere mentions that the server formats anything at all, a person of skill in the art would be led to the conclusion that the web pages and virtual coupons are formatted by the provider. Thus, Mankoff's server, which the Office Action seems to have analogized to Applicants' claimed transmitter, does not anticipate Applicants' claimed means for formatting by the transmitter the contextually-relevant information because by the time the server receives the information, it is already formatted. For these reasons, it is submitted that claims 41 and 44 are not anticipated by Mankoff.

It is further submitted that claim 45 is not anticipated by Mankoff because Mankoff does not disclose, in Mankoff's client, a way for the user to specify a preference for a virtual coupon and thus indicate Applicants' user preference for formatted contextually-relevant information. Applicants' claimed processing module is included in Applicants' client, and Applicants claim that the processing module in the *client* can determine when the formatted contextually-relevant information is preferred by the user. On the contrary, in Mankoff, any possible user preference

is determined solely by the user's requesting a web page, and without regard to the virtual coupon, which the Office Action has analogized to Applicants' claimed contextually-relevant information, and which is stored on the *server's* database by a *provider*. For this reason(s) it is submitted that, claim 45 is not anticipated by Mankoff.

It is submitted that dependent claim 42 is not anticipated by Mankoff based, at least, on its dependence on independent claim 41.

### III. CLAIM REJECTIONS UNDER 35 USC § 103

On pages 4-9, in paragraph 5, the Office Action states that claims 1, 3-4, 9-14, 17, 21-40, 42-43, and 46-47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Treyz. On page 9, in paragraph 6, the Office Action states that claims 30, 43, and 46-47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Lake.

With respect to claim 1, it is submitted that Mankoff, Treyz, or their combination does not make obvious Applicants' claimed means for defining a context in said transmitter because Mankoff states the information included in a virtual coupon in FIG. 3, and that "*providers* of virtual coupons preferably store those coupons in the database" (Mankoff, col. 3, lines 62-63) [Emphasis added], from which the virtual coupon is drawn and served to the client. Because Mankoff's "providers" are different from Mankoff's web server (Mankoff states, the server "may provide the virtual coupon service for a fee", in other words, providers may pay for the service of having the server present their virtual coupons to the client), it is submitted that if any context is being defined in Mankoff, it is being done at the *provider*, not at the server. Thus, because neither Mankoff nor Treyz discloses or suggests Applicants' claimed means for defining a context in a *transmitter*, it is submitted that claim 1 is not obvious under 35 U.S.C. § 103.

With respect to claims 1, 9, 29, 34, and 37, it is submitted that Mankoff, Treyz, or their combination does not make obvious Applicants' claimed information formatted by the transmitter because Mankoff's server's stated activity is to serve the virtual coupon, that has been previously stored by Mankoff's provider on the server's database, to the client, and also

that that “virtual coupons are served [by the server] with web pages in a conventional manner” (Mankoff, col. 3, lines 65-66). Applicants respectfully point out that Mankoff’s “conventional manner” suggests that web pages (and their coupons) are provided to the server conventionally, i.e. already-formatted. Since Mankoff’s *provider* is formatting the web pages and virtual coupons, then it is not necessary for Mankoff’s *server* to provide Applicants’ claimed information formatted by the transmitter, and Mankoff does not disclose or suggest such a capability. For these reasons, neither Mankoff nor Treyz nor their combination can make obvious Applicants’ claims 1, 9, 29, 34, and 37 under 35 U.S.C. § 103.

With respect to claims 1, 9, 17, 25-27, 29, 34, 36, 37, and 40, it is submitted that Applicants’ claimed XML element is not made obvious by Mankoff, Treyz, or their combination because XML is one of many languages that could be used to format information, and there is not a reasonable certainty that Applicants’ claimed XML element necessarily results from the systems of either Mankoff or Treyz (*In re Brink*, 164 USPQ 247 teaches that if there is not a reasonable certainty that the claimed subject matter will necessarily result, the rejections fails.) Nowhere does Mankoff state any form at all for Mankoff’s transmission between Mankoff’s client or server and Mankoff’s PDA, including XML, and further, there is no mention whatsoever of XML in Treyz. Still further, the Office Action has not provided a basis in fact and/or technical reasoning to reasonably support the determination that Applicant’s claimed XML necessarily flows from the teachings of Mankoff or Treyz because there is no reason given in either Mankoff or Treyz why the system of Mankoff or Treyz would prefer one language over another or even use a mark-up language. (*Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) teaches that “[I]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”). Still further, there is no basis in fact and/or technical reasoning to reasonably support the determination that Applicants’ claimed XML element necessarily flows from the teachings of Mankoff or Treyz because there are other possible languages and formats that could be used. For these reasons, it is submitted that Applicants’ claims 1, 9, 17, 25-27, 29, 34, 36, 37, and 40 are not made obvious under 35 U.S.C. § 103 by Mankoff, Treyz, or their combination.

With respect to independent claims 1, 9, 25, 29, 34, and 37 and their dependent claims, it is submitted that nowhere in either Mankoff or Treyz is there a suggestion that Mankoff could be modified to include the capabilities of Treyz because Mankoff nowhere suggests an association between the reception of coupons and the range of the retail store, and Treyz nowhere suggests a centralized server such as Mankoff states for distributing coupons. *Uniroyal v. Rudkin-Wiley*, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) teaches that for prior art references to be combined to render obvious a subsequent invention under 35 U.S.C. § 103, there must be something in the prior art as a whole that suggests the desirability, and thus the obviousness, of making the combination, and that the Office Action must point to a teaching in the art that supports the combination or modification for the rejection to stand. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) teaches that the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. Thus, because there is no suggestion in the prior art of the desirability to modify Mankoff according to Treyz, it is submitted that independent claims 1, 9, 25, 29, 34, and 37 and their dependent claims are not made obvious under 35 U.S.C. § 103 by Mankoff, Treyz, or their combination.

With respect to claim 3, it is submitted that Mankoff, Treyz, or Official Notice don't make obvious Applicants' claimed diffuse infrared signal having a wavelength substantially in the range of 850 nanometers to 1250 nanometers because the infrared spectrum spans 750 nanometers to 25 micrometers ( $10^{13} - 4 \times 10^{14}$  Hz), and nowhere does either reference disclose or suggest a particular range within the infrared spectrum that accommodates their technologies. It is submitted that it is not instantly and unquestionably demonstrated as being well-known in the art that Applicants' claimed wavelength range would be used in the systems of either Mankoff or Treyz. (According to the *MPEP*, § 2144.03, it would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known [Emphasis in original].) It is also submitted that there is no evidence in the record to support an assertion of common knowledge (or Official Notice), nor is the basis for such reasoning set forth explicitly, nor are factual findings predicated on sound technical and

scientific reasoning presented in the Office Action. The MPEP further states that there must ordinarily be some form of evidence in the record to support an assertion of common knowledge, and that if such notice is taken, the basis for such reasoning must be set forth explicitly, and the Office Action must provide specific factual findings predicated on sound technical and scientific reasoning. It is therefore submitted that claim 3 is not made obvious by Mankoff and Treyz under 35 U.S.C. § 103.

With respect to claims 4, 11, 24, 28, and 32, it is submitted that it is not inherent in either Mankoff or Treyz that Applicants' claimed diffuse infrared signal is generated by modulating an electric light because an infrared signal can be generated in many ways. The general rule of inherency may not be relied upon because the consequences of following either Mankoff or Treyz does not always inherently produce Applicants' claimed diffuse infrared signal that is generated by modulating an electric light. Further, there is not a reasonable certainty that Applicants' claimed diffuse infrared signal generated by an electric light will necessarily result from either Mankoff or Treyz or their combination because neither gives any indication whatsoever concerning the generation of the infrared signal. Finally, the Office Action provides no basis in fact and/or technical reasoning to support the determination that the generation of a diffuse infrared signal by modulating an electric light necessarily flows from the teachings of Mankoff and Treyz. For these reasons, it is submitted that claims 4, 11, 24, 28, and 32 are not made obvious by Mankoff or Treyz or their combination under 35 U.S.C. § 103.

With respect to claims 10, 22, 33, and 38, it is submitted that neither Mankoff nor Treyz nor their combination discloses or suggests Applicants' claimed handheld device having a means for extracting including a plug-in that executes when an interest is expressed because, while Mankoff states that both Mankoff's "*representative web client*" (a personal computer, as distinguished from a handheld device in Mankoff, col. 3, lines 16-17) and Mankoff's *server* can support application plug-ins (Mankoff, col. 3, lines 8 and 15), Mankoff nowhere discloses or suggests that Mankoff's *handheld device* supports plug-ins. Mankoff states that the handheld device typically includes a handheld stylus for inputting information to the device and synchronization software, and that representative PDA devices include a x86-, PowerPC.RTM.- or RISC-based processor, a realtime operating system such as WindRiver VXWorks.TM., QSSL

QNXNeutrino.TM., PalmOS, or Microsoft Windows CE, a Web browser or other graphics viewer, device drivers, control software, a modem, non-volatile memory, and system memory (Mankoff, col. 3, lines 19-33). However, Mankoff does not disclose or suggest Applicants' handheld device having a means for extracting that includes a plug-in. Neither does Treyz either disclose or suggest Applicant's claimed plug-in. It is therefore submitted that claims 10, 22, 33, and 38 are not made obvious by Mankoff or Treyz or their combination under 35 U.S.C. § 103.

With respect to claims 25 and 39, it is submitted that Mankoff does not disclose or suggest Applicants' claimed information being of interest to the user of the handheld device *if the handheld device is located within the coverage area* because, in the system of Mankoff, the user receives virtual coupons based on the user's access of a web site that has previously been associated with the coupons, but there is no association in Mankoff between the location of the handheld device with respect to the coverage area of the transmitter and the user's interest level in the virtual coupons. Mankoff does not disclose or suggest any relationship between transmitted information and Applicants' claimed coverage area at all. Further, as explained above, nowhere in either Mankoff or Treyz is there a suggestion that Mankoff could be modified to include the capabilities of Treyz. For these reasons, it is submitted that Applicants' claims 25 and 39 are not made obvious by Mankoff or Treyz or their combination under 35 U.S.C. § 103.

With respect to claims 26-27 and 36, it is submitted that neither Mankoff nor Treyz nor their combination discloses or suggests Applicants' claimed emitting a time element associated with an XML element, an integrity element, and temporal context for the user because, in Mankoff, (1) the virtual coupon's expiration date is a characteristic of the coupon, and thus Mankoff is not performing Applicants' claimed emitting of the time element, and (2) the coupon's expiration date is unrelated to any of an XML element, an integrity element, or a temporal context for the user because the expiration date is simply a part of the virtual coupon information. In Treyz there is no reference whatsoever to Applicants' claimed emitting a time element in conjunction with an XML element and an integrity element because Treyz's references to time are limited to setting timers for user responses or reminders, or time-tagging information, activities which are not related to Applicants' claimed XML element nor

Applicants' claimed integrity element. It is therefore submitted that claims 26-27 and 36 are not made obvious by Mankoff, Treyz, or their combination under 35 U.S.C. § 103.

With respect to claims 30, 43, and 46, it is submitted that neither Mankoff, nor Lake, nor their combination makes obvious Applicants' claimed broadcast XML element or broadcast signal having contextually-relevant information because nothing in either Mankoff or Lake suggests the desirability, and thus the obviousness, of combining Mankoff and Lake because they are approaching a similar problem in two completely different ways. (*Uniroyal v. Rudkin-Wiley*). Lake's system is configured such that a radio broadcast system sends a radio signal that includes digital information to a receiver unit. The receiver unit sends the audio portion of the signal to a radio and the digital portion of the signal, including coupons, to a user's computer. Thus, in Lake, the user already has the coupons by the time the user accesses the web site. On the contrary, Mankoff's system relies on the web pages requested by the user to provide the virtual coupons. Further, if Lake were combined with Mankoff, Mankoff would be rendered unsatisfactory for its intended purpose because virtual coupons could possibly be coming from two sources simultaneously. This duplication could present confusion to the user or loss of revenue for the provider, among other possibilities. (*In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) teaches that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.) For these reasons, it is submitted that Applicants' claims 30, 43, and 46 are not made obvious by Mankoff and Lake under 35 U.S.C. § 103.

It is submitted that dependent claims 7 and 8 are not made obvious under 35 U.S.C. § 103 at least based on their dependence on independent claim 1, that dependent claims 12-14 are not made obvious at least based on their dependence on independent claim 9, that dependent claim 21 is not made obvious at least based on its dependence on independent claim 25, that dependent claim 31 is not made obvious at least based on its dependence on independent claim 29, that dependent claim 35 is not made obvious at least based on its dependence on independent claim 34, and that dependent claim 47 is not made obvious at least based on its dependence on independent claim 44.



#### IV. ALLOWABLE SUBJECT MATTER

The Office Action states that claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

On page 10, the Office Action states that the reason for allowance for claim 18 is that the prior arts fail to disclose “said integrity element includes a checksum value, said checksum value representative of said information; a size value, said size value indicating the size of said information; a seed value, said seed value being used in computing said checksum value, and an operator, said operator being used in conjunction with said size value and said seed value to compute said checksum value”, as cited in the claim.

It is submitted that claim 18 is not made obvious under 35 U.S.C. § 103 based, at least, on its dependence upon claim 9, as argued above.

V. CONCLUSION

It is submitted that claims 1, 3, 4, 7-14, 17, 18, 21, 22, and 24-47 are now in condition for allowance.

Applicants respectfully request that the Examiner withdraw all rejections and objections, and find claims 1, 3, 4, 9-14, 17, 18, 21, 22, and 24-47 allowable for the reasons stated above, and further respectfully request that a timely Notice of Allowance be issued in this case. Applicants respectfully point out that, since no rejection has been stated for claims 7 and 8, Applicants assert that these claims have not been made obvious under 35 U.S.C. § 103.

Although no new fees are anticipated, the Commissioner for Patents is authorized to charge any additional fees or credit overpayment to Deposit Account No. 03-2410, Order No. 12078-141.

The following information is presented in the event that a call may be deemed desirable by the Examiner: KATHLEEN CHAPMAN (617) 345-3210

Respectfully submitted,  
Noah J. Ternullo et al., Applicants

Date: August 1, 2006

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